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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,862	04/09/2004	Guido Schmitz	245964US0	8700

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EXAMINER

TRAN, THAO T

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,862

Applicant(s)

SCHMITZ ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendment filed on 9/09/2005.
2. Claims 1-2, 5, 7-17, and 19-20 are currently pending in this application. In this amendment, claims 3-4, 6, and 18 have been canceled. Claims 1, 5, 7, have been amended.

Claim Objections

3. Claims 1-2, 5, 7-17, and 19-20 are objected to because of the following informalities:

In claims 1, 5, and 7, "innermost I layer", all occurrences, should be changed to --innermost layer I--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. In view of the Office action of 6/21/2005, the rejection of claims 1, 6-7, and 18-20 under 35 U.S.C. 102(b) as being anticipated by Semegen et al. (US Pat. 2,827,098), has been withdrawn due to the Amendments made thereto.

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6. Claims 1-7, 9-12, 15, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ries (US Pat. 5,798,048).

Ries teaches a plastic fuel filter having at least three layers, wherein the inner and outer layers are made of a plastic of component A, and embedded between them a layer of a plastic component B (see abstract; Fig. 1-2). Component A can be of polyester molding and component B can be of polyamide, polyolefin, or EVOH (see col. 3, ln. 45-49). Polyester used can be polyethylene terephthalate (see col. 5, ln. 49); polyamide can be PA10, PA11 and can have an impact modifier such as EPM or EPDM (see col. 3, ln. 51-55; col. 4, ln. 39-41); polyolefin can be high, intermediate, or low density linear polyethylene and further contains ethylene vinyl alcohol containing up to about 40% weight of ethylene (see col. 4, ln. 61-67; col. 5, ln. 1). The inner and outer layers can further contain additives such as electrically conductive additives (see col. 6, ln. 65-67).

Although Ries is silent with respect to the conductivity of the inner layer, since the reference teaches the inner layer comprising polyester, the invention of Ries would inherently have the same properties such as conductivity.

7. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Boer et al. (US Pat. 6,355,358).

Boer teaches a multilayer composite, comprising layer I of polyamide molding composition and layer II of polyester molding composition; and an adhesion promoter layer in between layers I and II (see abstract). The polyamide molding composition contains PA 10 or PA 11; an impact modifier, such as ethylene propylene or ethylene propylene diene copolymers; and additives, such as plasticizers or electroconductive fillers (see col. 6, ln. 1-8, 39-45, 55-58). The

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polyester composition includes polyethylene terephthalate, and up to 40% by weight of other thermoplastics, such as impact modifying rubbers and electroconductive fillers (see col. 7, ln. 25-45). The adhesion promoter composition comprises polyamide, polyester, and 40% parts by weight of additives such as impact modifying rubber, such as EPM functionalized with 1% maleic anhydride and other additives (see col. 8, ln. 7-25; col. 10, ln. 65-67; col. 12, ln. 4-5).

Although Boer is silent with respect to the conductivity of the inner layer, since the reference teaches the inner layer comprising polyester, the invention of Boer would inherently have the same properties such as conductivity.

Claim Rejections - 35 USC § 103

8. In view of the Office action of 6/21/2005, the rejection of claims 13-14 as being unpatentable over Semegen, Ries or Boer as applied to claims 1 and 12 above, and further in view of Kito et al. (US Pat. 6,491,994), has been withdrawn due to the Amendments made thereto.

9. In view of the Office action of 6/21/2005, the rejection of claims 16-17 as being unpatentable over Semegen, Ries, or Boer as applied to claim 1 above, and further in view of Oishi et al. (US Pat. 5,849,376), has been withdrawn due to the Amendments made thereto.

Response to Arguments

10. Applicant's arguments filed on 9/09/2005 have been fully considered but they are not persuasive.

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With respect to the rejection of claims 1-7, 9-12, 15, 18-20 as being anticipated by Ries, Applicants contend that Ries does not teach or suggest the inner polyester layer having the presently claimed conductivity. However, Applicants are reminded that although the reference is silent with respect to the conductivity of the inner layer, since the reference teaches the inner layer comprising polyester, the invention of Ries would inherently have the same properties such as conductivity since the reference teaches the inner layer comprising polyester as presently claimed, the invention of Ries would inherently have the same conductivity.

Applicants further assert that Boer does not anticipate claims 1-12, because the reference does not teach a layered structure with a polyester inner layer having the presently claimed conductivity. The same arguments are as presented above with respect to the reference of Ries.

In summary, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
November 28, 2005



THAO T. TRAN
PATENT EXAMINER